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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,458	08/14/2006	Andrew Michael Halliday	67688	7173

48940 7590 12/13/2010
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EXAMINER

ATKISSON, JIANYING CUI

ART UNIT	PAPER NUMBER
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3742

MAIL DATE	DELIVERY MODE
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12/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,458	Applicant(s) HALLIDAY ET AL.	
	Examiner JIANING ATKISSON	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 41-56 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-40 is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed on 9/28/10 is acknowledged. Claims 1-40 are now pending, claims 41-56 are withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-40 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-35, 52-67 of copending Application No. 10/589,459. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: both applications are claiming an insert for a beverage machine and as per *In re Goodman* 11 F 3d 1046 29 USPQ2d 2010(Fed Cir 1993) a "two ways" analysis is required and at least one of the applications must anticipate the other in a genus species relationship.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804

2. Claim 1-40 are rejected on the ground of nonstatutory double patenting over claims 1-31 of U. S. Patent No. 7673558 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an insert for a beverage machine with inlet and outlet on the lower surface of the insert.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficient" in the phrase of "sufficient force" in claim 18 is a relative term or term of degree which renders the claim indefinite. The term "sufficient" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 19-40 are rejected since they are dependent on claim 18.

Claim Rejections - 35 USC § 103

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Cai (US 7,032,503), hereafter Cai '503.

Regarding claim 1, Burrows teaches an insert (12) for use in a beverage preparation machine (10) of a type comprising a brew head (28) suitable for receiving a rigid or semi-rigid cartridge (cavity 32 can receive cartridge), the brew head comprising an upwardly directed inlet (62) for supplying water to the brew head, a downwardly directed outlet (79) for outflow of beverage produced by the machine, and a closure mechanism (77) moveable between open and closed configurations, the insert comprising a receptacle (12), the receptacle having an opening (top opening of 12) through which, in use, a quantity of beverage ingredients (ground coffee, etc) may be loaded into the receptacle, a lower portion of the insert comprising an inlet (64) and an outlet (holes on mash 78), wherein, in use, on insertion of the insert into the brew head of the beverage preparation machine and movement of the closure mechanism into the closed position to thereby close the opening of the receptacle to define a brewing volume containing the quantity of beverage ingredients, and on inserting the insert into the brew head the inlet (64) and outlet (mash holes) of the insert are arranged to communicate respectively with the upwardly directed inlet (62) and the downwardly

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directed outlet (79) of the brew head such that, in use, water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert to flow out of the downwardly directed outlet of the brew head (col. 5, lines 49-54, col. 6, lines 58-62).

Regarding claims 1, 14-15, Burrows does not teach explicitly a sealing means, and the sealing means is contactable with, and sealable against, the brew head; or the sealing means comprises a ring seal or an O-ring for sealing around a periphery of the brewing volume.

In the same field of endeavor of beverage brewing machine, Cai '503 teaches a sealing means (a ring seal 25 or O-ring 16) used to form airtight seal for a brewing chamber (col. 3, lines 12-14).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use in Burrows the ring seal or O-ring as taught by Cai between the basket 12 and the cap 77 in order to form airtight connection there-between thus to ensure no hot steam escapes outside to burn the user.

Regarding claim 2, Burrows in view of Cai teaches that the insert as claimed in claim 1 wherein the quantity of beverage ingredients (ground coffee) loaded in use into the receptacle are loose (ground coffee is loose).

Regarding claim 3, Burrows in view of Cai teaches that the insert as claimed in claim 2 wherein the insert comprises filtering means (78) between the brewing volume and the outlet of the insert.

Regarding claim 16, it is well known that O-rings are commonly made from an elastomeric material.

Regarding claim 17, Burrows in view of Cai teaches that the insert as claimed in claim 1, wherein the receptacle is cup-shaped and wherein the cup is upwardly directed when the insert is located in said machine (Fig. 6).

3. Claims 4-13, 18-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Cai (US 7,032,503), hereafter Cai '503; and further in view of Cai (US 6,777,007), hereafter Cai '007.

Regarding claim 4-9, Burrows in view of Cai '503 teaches the limitations of claim 1, but does not teach explicitly that the insert as claimed in claim 1 wherein the quantity of beverage ingredients loaded in use into the receptacle are contained in a container comprising filtering means (*Regarding claim 4*); or that the insert as claimed in claim 4 wherein the container is flexible (*Regarding claim 5*); or the container is formed at least in part from a filtering membrane (*Regarding claim 6*); or the container is a filter bag (*Regarding claim 7*); or the container is a rigid or semi-rigid cartridge or the shape of the container (*Regarding claims 8-9*).

In the same field of endeavor of coffee maker, Cai '007 teaches a brewing pot (Figs. 4, 9) to use in a brewing chamber for making coffee, espresso, hot chocolate, mocha, latte or the like (Abstract) to avoid messiness in handling loose coffee grounds (Col. 1, lines 23-24), and the pot comprising filtering means (filtering paper) (*Regarding claim 4*); and the pot is flexible (*Regarding claim 5*); and the pot is formed at least in part

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from a filtering membrane (*Regarding claim 6*); and the pot is a filter bag (*Regarding claim 7*); and the pot is a semi-rigid cartridge and round (Fig. 9, plate 101 is rigid) (*Regarding claims 8-9*).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use the pod taught by Cai '007 in the coffee maker of Burrows so that one or more pods of pre-determined dose of coffee can be used in Burrows to make one or more cups of different types beverage and to avoid messiness in handling loose coffee grounds (Col. 1, lines 23-24).

Regarding claim 10, Burrows teaches that the opening of the receptacle (12, Fig. 6) is upwardly directed.

Regarding claim 11, Burrows teaches that the insert as claimed in claim 10, wherein the sealing means (77) is located on an upper portion of the insert (Fig. 6).

Regarding claim 12, Burrows teaches that the insert as claimed in claim 11 wherein the sealing means is located on an upper rim of the insert (Fig. 3).

Regarding claim 13, Burrows teaches that the insert as claimed in claim 11, wherein the sealing means is separate from the receptacle (Fig. 6).

Regarding claims 18-20, Burrows in view of Cai '503 teaches the limitations of claim 17, the combination further teaches that the insert is rigid or semi-rigid, such that pressure applied, in use, to the insert by the closure mechanism (77) of the beverage preparation machine on closing of said closure mechanism squeezes the insert with sufficient force for the sealing means to seal against the brew head (col. 6, lines 25-28) (*Regarding claim 18*); an viewing window on cap 77 (col. 7, lines 10-11) (*Regarding*

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claim 19); and the insert is rigid or semi-rigid, such that pressure applied, in use, to the insert by the closure mechanism of the beverage preparation machine on closing of said closure mechanism seals a lower surface of the insert against the inlet of the brew head of the beverage preparation machine (col. 5, lines 38-41) (*Regarding claim 20*).

Regarding claim 22, Burrows teaches that the insert is formed from more than one piece (77, 12).

Regarding claim 23, Burrows teaches that the wherein the insert is disc-shaped.

Regarding claim 24, Burrows teaches that the insert is formed from plastic (col. 5, line 46).

4. Claims 21, 23-24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Cai (US 7,032,503), hereafter Cai '503; and further in view of Cai (US 6,777,007), hereafter Cai '007; and in view of Halliday et al (US 2004/0197444), hereafter Halliday.

Regarding claim 21, Burrows in view of Cai '503 and Cai '007 teaches the limitations of claims 20, but does not explicitly disclose that the insert is formed as one piece.

In the same field of endeavor of beverage brewing machine, Halliday teaches an insert (Figs. 11, 18, 29, 34) with the claimed features of the insert of claim 20 and is formed as one piece.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to make the cap 77 and the receptacle 12 as one piece, thus accurate

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amount of coffee can be prepackaged, and the insert thus made can be used as cartridges and thus making to increase the convenience and accuracy in coffee making.

Regarding claim 23, Burrows teaches that the wherein the insert is disc-shaped.

Regarding claim 24, Burrows teaches that the insert is formed from plastic (col. 5, line 46).

Allowable Subject Matter

5. Claims 25-40 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: allowance of claims 25-40 is indicated because none of the prior art of record, alone or in combination, appears to teach, or fairly suggest or render obvious an insert to use in a brew head wherein the insert having an inlet and an outlet in the lower portion of the insert and the inlet and the outlet are coplanar, as recited in claim 25.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JIANYING ATKISSON whose telephone number is (571)270-7740. The examiner can normally be reached on Mon-Friday. 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JIANYING ATKISSON/
Examiner, Art Unit 3742
12/10/10

/Henry Yuen/
Supervisory Patent Examiner,
TC 3700